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Filed : April 15, 2004

REMARKS

Claim 1 has been amended to clarify the invention. Support can be found in the paragraph beginning at page 1, line 18, and the figures, for example. Claims 12-17 have been added. Support can be found in the paragraph beginning at page 10, line 7, the paragraph beginning at page 6, line 5, and the paragraph beginning at page 6, line 7, for example. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection of Claims 1-5 and 8-9 Under 35 U.S.C. § 103

Claims 1-5 and 8-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,700,623 (Anderson) as evidenced by US 6,197,418 (Cloots). Claim 1 is independent and has been amended to clarify the invention. Applicant respectfully traverses this rejection.

First, the Examiner asserts:

“[A]lthough Anderson fails to teach that the polymer film is an optical one, ... Anderson discloses prior art which teaches a transparent polymer film which is an optical film by virtue of its transparency.”

However, in the prior art described in Anderson, the transparent polymer film is a transparent support for thermostable photographic bar codes (col. 2, lines 4-10). Clearly, the transparent support is not “an optical film for improving display-quality of a display screen” recited in Claim 1. The recitation “for improving display quality of a display screen” is not simply an intended use but is a structural limitation which indicates that the film is a functional film. The transparent support cannot be an optical film simply by virtue of its transparency. In Anderson, including the prior art section, absolutely no “optical film” is disclosed.

Second, as the Examiner asserts, “although Anderson fails to teach that the polymer film is an optical one, ... Anderson discloses prior art which teaches a transparent polymer film.” However, Anderson specifically states: “The label includes an opaque polymer film substrate and a silver halide photographic emulsion layer that forms the bar code image. ... The antistatic backing layer of the invention also provides exceptional adhesion to the opaque substrate and to the curable, pressure-sensitive adhesive layer that overlies the backing layer” (col. 3, lines 52-67) (Emphasis added). Thus, Anderson does not teach or suggest using a transparent polymer film

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with his antistatic backing layer, but Anderson contrasts prior art's transparent polymer film and his opaque polymer film. Please note that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.01.

Third, Anderson states:

“Especially preferred antistatic agents include the cross-linked vinylbenzyl quaternary ammonium polymers of U.S. Pat. No. 4,070,189, potassium cellulose succinate salts described in U.S. Pat. No. 4,459,352, or water soluble interpolymers of alkali metal salts of styrene sulfonic acid such as those described in U.S. Pat. Nos. 4,960,687, 4,891,308, 4,999,276, for example. Other suitable antistatic agents include polyacetylenes, polyanilines, polythiophenes and polypyrroles. These antistatic agent are described in U.S. Pat. Nos. 4,237,194, and 5,370,981, and Japanese Patent Applications 2282245 and 2282248.” (col. 5, line 65 through col. 6, line 10)

Thus, Anderson lists both water non-soluble polymers and water soluble polymers and clearly does not recognize the significance of water soluble polymers.

Fourth, the Examiner asserts:

“[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made, to have laminated the antistatic layer of Anderson on at least one side of an optical film, in order to obtain an optical film free of static problems.”

However, Anderson’s “static problem” is that because photographic bar code materials are prone to the generation of static electric charges during the manufacture of the bar code material, static charges may discharge at any point during the manufacture of the label prior to developing the bar code image thus making the bar code label nonusable (col. 2, lines 25-30). That is, in Anderson, the antistatic layer improves manufacturability of the bar code label and protects the label itself. In contrast, the static problem to be solved in Claim 1 is destruction of circuits or the occurrence of disorder of pictures of a display panel to which an optical film is attached when a protective film is removed from an optical film (pages 2 and 3). In Claim 1, the antistatic layer inhibits destruction of circuits or the occurrence of disorder of pictures of a display panel and the static problem to be solved is unrelated to the manufacturing process or protection of the optical film itself.

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“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998), M.P.E.P. 2143.01. Here, none of the above sources can be established.

Fifth, in Anderson, “[a] second primer is superposed on the second side of the opaque polymer film and an antistatic layer is superposed on the second primer layer” (col. 3, lines 32-34). In the examples of Anderson, “[t]he following bar code labels were prepared by applying an antistatic backing layer onto a 100 µm thick opaque polyethylene terephthalate substrate that had been previously coated with primer layer on both sides” (col. 6, lines 59-62). Thus, in Anderson, the antistatic layer must be formed on the second primer layer and is not in contact with the opaque polymer film. In contrast, in Claim 1, the antistatic layer is laminated on and in contact with at least one side of the optical film.

In view of the foregoing, Anderson does not fairly teach or suggest Claim 1 and could not render Claim 1 obvious. The remaining claims depend from Claim 1, and at least for this reason, the remaining claims also could not be obvious over Anderson. Thus, this rejection is improper and Applicant respectfully requests withdrawal of this rejection.

Rejection of Claims 6-7 and 10-11 Under 35 U.S.C. § 103

Claims 6-7 and 10-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of US 6,503,581 (Shibue). Applicant respectfully traverses this rejection.

The Examiner asserts:

“[B]ecause Shibue teaches that a protective layer of polyester or polycarbonate is provided to minimize optical deformation during the manufacture of a polarizing plate, ... it would have been obvious to one of ordinary skill in the art ... to have laminated the polarizing plate of Shibue to the antistatic optical film of Anderson, in order to obtain a polarizing plate protected from optical deformation and static electric charges during manufacture.”

However, Shibue states:

“In order to minimize optical deformation such as abrasion and the like which are formed during maintaining the orientation and preparing a polarizing plate, a protective layer may be provided.” (col. 19, lines 3-5)

Anderson states:

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"Such photographic bar code materials are prone to the generation of static electric charges during the manufacture of the bar code material. Such static charges may discharge at any point during the manufacture of the label prior to developing the bar code image thus making the bar code label nonuseable." (col. 2, lines 25-30)

Thus, Anderson's problem is static electric charges, whereas Shibue's problem is abrasion, and they are dissimilar. Shibue does not teach or even suggest protecting a polarizing plate from static electric charges, and Anderson does not teach or even suggest protecting a bar code label from abrasion. Further, as discussed earlier, Anderson's support is not an optical film by definition. The Examiner appears to assert that Shibue and Anderson have a common optical deformation problem. However, there is no fair basis for supporting the Examiner's position. Shibue's polarizing film and Anderson's bar cod label are dissimilar to one of ordinary skill in the art with respect to the structures of films and the problems to be solved, and they could not reasonably be combined.

Further, as the Examiner asserts, "Shibue teaches that a protective layer of polyester or polycarbonate is provided." However, the protective layer is not an optical film by definition. Furthermore, in Shibue, the protective layer is made of polyester or polycarbonate, whereas in Claim 7, the optical film is made of polycarbonate or norbornene.

"The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.01. Here, as explained above, Anderson and Shibue are very different, and a combination of these is in no way suggested. Thus, this rejection based on a combination of Anderson and Shibue is improper, and Applicant respectfully requests withdrawal of this rejection.

New Claims

Claims 12-17 have been added. These claims depend ultimately from Claim 1, and at least for this reason, these claims could not be obvious over the above prior art references. Additionally, Claims 14 and 15 further recite "a hydrophilic functional group in a molecule," which improve

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water solubility of the molecule and makes the preparation of the polymer easier (page 10, lines 7-17). This feature is not taught or suggested by the prior art references. Claim 17 further recites "a size of 1 µm or less," which gives a uniform coated layer (page 6, lines 7-12). This feature is not taught or suggested by the prior art references. Also, the recitation of Claim 16 is not taught or suggested by the prior art references. Thus, for the additional reasons above, these claims could not be obvious over the prior art references.

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 10/28/2005

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